

NOKIA.4010US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Amit MATE et al.
Application No.: 10/030,207
Confirmation No.: 8979
Filing Date: August 10, 2004
Title: Method and System for Data Reception Acknowledgment
Art Unit: 2112
Examiner: Joseph D. Torres

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

November 3, 2008

REQUEST FOR RECONSIDERATION

Sir:

Applicants acknowledge the six-way Restriction Requirement of claims 23-47 dated October 2, 2008 in this application. It is respectfully requested that the Restriction Requirement be reconsidered and withdrawn as untimely or otherwise inappropriate at this stage of the prosecution of this application.¹ Furthermore, it is submitted that the restriction requirement is not proper so long as there is no supplemental or corrected Office Action that responds to applicants' outstanding argument made on September 7, 2007 against the §101 rejection of claim 47.

¹ This Request is not an attempt to respond to the merits of the restriction requirement.

Background

This application is a national stage application filed on December 31, 2001. A Petition pursuant to 37 C.F.R. § 1.47(a) was filed on September 30, 2002 due to an unavailable inventor.

There have been four Office Actions in this application prior to the current Restriction Requirement. The second Office Action dated May 7, 2007 was a final rejection of claims 23-47. Applicants filed an Amendment, a Rule 131 Declaration, and a Request for Continued Examination in response to the second Office Action. The Amendment filed on September 7, 2007 included an argument (based on the Federal Circuit's Beauregard decision) against the rejection of claim 47 as being non-statutory subject matter under 35 USC § 101.

The third Office Action dated January 11, 2008 repeated the rejection of claim 47 as being non-statutory subject matter under 35 USC §101, but did not respond to applicants' argument against the rejection based on the Federal Circuit's Beauregard decision. On April 11, 2008, applicants filed a Request for Clarification asking (among other things) that the argument against the §101 rejection be answered and asserting that the third Office Action was incomplete without such an answer. Applicants indicated that they regarded the Beauregard decision as binding precedent holding that a "computer program embodied in a tangible medium" was patentable subject matter and as being directly on point and definitively deciding the §101 rejection of claim 47 in this application.

An interview was conducted on May 1, 2008 wherein the Examiner refused to respond on the written record to applicants' argument against the §101 rejection and also refused to state the reason for refusing to respond to applicants' argument. The Examiner further stated in the Interview that he would regard the application as abandoned if applicants did not file a timely response to the third Office Action. A fourth Office Action was mailed on May 28, 2008 in which the Examiner corrected other errors in the third Office Action, but did not respond to applicants' argument against the §101 rejection. Applicants filed an Amendment in response to the third and fourth Office Action on July 11, 2008. In the Amendment, applicants referred back to and repeated their Request for Clarification.

The currently outstanding six way Restriction Requirement was mailed on October 2, 2008 in accordance with 37 CFR 1.499. It makes no reference to the procedural posture of this application.

Discussion

According to 37 CFR 1.499, a restriction requirement "may be made before any action on the merits but may be made at any time before the final action at the discretion of the examiner" (underlining added). As indicated above, a final action was mailed in this application on May 7, 2007. Therefore, the outstanding Restriction Requirement is untimely under the plain language of Rule 499 because it was not made before the final action.

Since the final action, there has been a Request for Continued Examination (RCE), a Rule 131 Declaration, an interview and multiple arguments filed. This additional activity and advanced stage of prosecution renders a restriction requirement at this point in time even more unwarranted and more untimely.

Furthermore, it should be carefully considered that applicants' previously filed Request for Clarification remains outstanding. In view of the long outstanding issue regarding the refusal to offer any response to applicants' argument made against the §101 rejection more than one year ago, the restriction requirement is further suspect as an attempt to avoid the obligation to respond to the Federal Circuit precedent relied upon as being dispositive of one of the claims to be restricted.

Conclusion

For at least the above reasons, applicants respectfully request that the restriction requirement be reconsidered and withdrawn as untimely or otherwise inappropriate at this point in the prosecution.

Respectfully Submitted,


Robert Bauer, Reg. No. 34,487

Dated: November 3, 2008